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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/034,045 | 12/27/2001 | Thomas E. Jacobs | 023720-0250 | 1658 |
| 26371 | 7590 | 06/29/2004 | EXAMINER | |
| FOLEY & LARDNER 777 EAST WISCONSIN AVENUE SUITE 3800 MILWAUKEE, WI 53202-5308 | | | BAHTA, ABRAHAM | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1775 | |

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|-----------------------------------|--|
| Office Action Summary | Application No. 10/034,045 | Applicant(s) JACOBS, THOMAS E. | |
| | Examiner Abraham Bahta | Art Unit 1775 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 and 56-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 and 56-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce (USP 6,434,873) or Rockwood (USP 4,556,588) in view of Van Houten '168.

Pierce teaches a decorative display such as a medallion (col. 5, lines 53-63) comprising a cavity wherein the insert is placed into the space defined by the cavity. The insert may be an embossed paper, embossed cardboard, embossed plastic, stamped metal sheet, a hologram and combinations thereof.

Rockwood teaches an emblem made of two parts, a base and a capped inlay. The base may be provided with depression to retain the inlay. See col. 2, lines 39-58. The reference teaches a rim may be provided around the base and the inlay may be sapped into place in the base member. The inlay may be a graphic bearing or embossed and may be in different shapes. See col. 3, lines 1-11 and lines 32-34.

Thus, Pierce and Rockwood teach an emblem or a decorative display such as a medallion device wherein a decorative insert may be placed in the space defined by the cavity formed in the base member.

Pierce or Rockwood do not require a plurality of inserts (three sets) having different characteristics; however, Van Houten teaches an article such as a wheel cover having interchangeable inserts snapped into turbine pockets of a wheel cover, so as to provide a variety of decorative contrasts between the turbine pockets and the rest of the vehicle wheel cover. An array of apertures, vents, or turbine pockets is disposed about the wheel cover. The turbine pockets are openings that extend through the wheel cover or alternatively can be closed depressions in one of the inboard or outboard surfaces of the wheel cover and the turbine pockets may take on any number of various geometries so that many different ornamental designs can be provided. See col. 5, lines 15-22.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the medallion of Pierce or the emblem of Rockwood by providing a plurality of interchangeable inserts having different shapes, color, outline and placing the plurality of the interchangeable inserts in the cavity or depression of the base of the medallion of Pierce or emblem of Rockwood as taught by Van Houten in order to provide, for example, a vehicle to which the emblem or decorative display may be attached in order to give unique or the desired look and/or visual effect.

Claim 2: Pierce and Rockwood teaches the medallion or emblem comprises a cavity or depression.

Claims 3-9: Pierce and Rockwood are silent regarding the color as recited in claim 3, each insert having different outline form other inserts as recited in claim 4, the outline being correlated to a portion of a motor vehicle as recited in claim 5, the surface profile being a flat, concave or convex, the indicia provided to the elements or inserts as recited in claims 8-9; however, since Van Houten's teaches the decorative inserts may be replaceable or interchangeable and that the turbine pocket may take on any number of various geometries so that many different ornamental designs can be provided, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the interchangeable inserts of Van Houten with various designs, shapes, colors and profiles in order to decorate or accent the medallion of Pierce or emblem of Rockwood or a vehicle according to the users individual taste.

Claims 10-12. Rockwood teaches the decorative emblem is configured to be attached to a vehicle. See col. 3, lines 56-61.

Claim 14. Pierce teaches the device is a medallion. See col. 5, lines 53-54.

Claim Rejections - 35 USC § 103

Claims 15-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce (USP 6,434,873) or Rockwood (USP 4,556,588) or in view of Van Houten '168.

Pierce and Rockwood are discussed above.

Pierce or Rockwood do not require a plurality of inserts (three sets) having different characteristics; however, Van Houten teaches an article such as a wheel cover having interchangeable inserts snapped into turbine pockets of a wheel cover, so as to provide a variety of decorative contrasts between the turbine pockets and the rest of the

Art Unit: 1775

vehicle wheel cover. An array of apertures, vents, or turbine pockets is disposed about the wheel cover. The turbine pockets are openings that extend through the wheel cover or alternatively can be closed depressions in one of the inboard or outboard surfaces of the wheel cover and the turbine pockets may take on any number of various geometries so that many different ornamental designs can be provided. See col. 5, lines 15-22.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the medallion of Pierce or the emblem of Rockwood by providing a plurality of interchangeable inserts having different shapes, color, outline and placing the plurality of the interchangeable inserts in the cavity or depression of the base of the medallion of Pierce or emblem of Rockwood as taught by Van Houten to provide, for example, a vehicle to which the emblem or decorative display may be attached in order to give unique or the desired look and/or visual effect.

Claim 16: Pierce and Rockwood teaches the medallion or emblem comprises a cavity or depression.

Claims 17-22: Pierce and Rockwood are silent regarding each insert having different out line form other inserts as recited in claim 17, the outline being correlated to a portion of a motor vehicle as recited in claim 18, the surface profile being a flat, concave or convex, the indicia provided to the elements or inserts as recited in claims 20-22; however, since Van Houten's teaches the decorative inserts may be replaceable or interchangeable and that the turbine pocket may take on any number of various geometries so that many different ornamental designs can be provided, it would have been obvious to one of ordinary skill in the art at the time the invention was made to

Art Unit: 1775

provide the interchangeable inserts of Van Houten with various designs, shapes, colors and profiles in order to decorate or accent the medallion or emblem or a vehicle according to the users individual taste.

Claims 23-24: Rockwood teaches the decorative emblem is configured to be attached to a vehicle. See col. 3, lines 56-61.

Claim 26. Pierce teaches the device is a medallion. See col. 5, lines 53-54.

Claim 27: Rockwood teaches the inlay may be attached to the base by a way of adhesive. See col. 3, lines 1-10.

Claim Rejections - 35 USC § 103

Claims 28-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Houten USP 6,517,168).

Van Houten teaches an article such as a wheel cover for a vehicle having interchangeable inserts snapped into turbine pockets of a wheel cover, so as to provide a variety of decorative contrasts between the turbine pockets and the rest of the vehicle wheel cover. An array of apertures, vents, or turbine pockets are disposed about the wheel cover. The turbine pockets are openings that extend through the wheel cover or alternatively can be closed depressions in one of the inboard or outboard surfaces of the wheel cover and the turbine pockets may take on any number of various geometries (which may be interpreted as characteristic of different shapes) so that many different ornamental designs can be provided. See col. 5, lines 15-22.

Van Houten does not require a first set, a second set and third set of inserts; However, Houten, as discussed above, teaches interchangeable inserts snapped into turbine pockets of a wheel cover in order to provide a variety of decorative contrasts between the turbine pockets and the rest of the vehicle wheel cover. Therefore, since Houten teaches interchangeable inserts may be provided it would have been obvious to one of ordinary skill in the art at the time the invention was made to have a provided a plurality set of inserts in order to provide a unique ornamental appearance for the article.

Claims 29-34: Houten teaches the decorative inserts may be replaceable or interchangeable and that the turbine pocket may take on any number of various geometries so that many different ornamental designs can be provided.

Claim Rejections - 35 USC § 103

Claims 56-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce '873 or Rockwood '588 in view of Houten '168.

Pierce which teaches a medallion comprising a base having a cavity wherein the insert may be placed in the cavity and Rockwood which teaches an emblem having a cavity and an insert are discussed above.

Pierce and Rockwood do not require a first, second and third set of inserts; however, Houten '168 teaches an article such as a wheel cover having interchangeable inserts snapped into turbine pockets of a wheel cover, so as to provide a variety of decorative contrasts between the turbine pockets and the rest of the vehicle wheel cover. An array of apertures, vents, or turbine pockets is disposed about the wheel

cover. The turbine pockets are openings that extend through the wheel cover or alternatively can be closed depressions in one of the inboard or outboard surfaces of the wheel cover and the turbine pockets may take on any number of various geometries so that many different ornamental designs can be provided. See col. 5, lines 15-22.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the medallion of Pierce or the emblem of Rockwood by providing a plurality of interchangeable inserts having different shapes, color, outline and placing the plurality of the interchangeable inserts in the cavity or depression of the base of the medallion of Pierce or emblem of Rockwood as taught by Van Houten to provide, for example, a vehicle to which the emblem or decorative display may be attached in order to give unique or the desired look and/or visual effect.

Claim 57: Pierce and Rockwood teaches the medallion or emblem comprises a cavity or depression.

Claim 58: Pierce or Rockwood do not teach a plurality of inserts that interface one another; Houten teaches the pocket inserts may be fully inserted into the turbine pocket. Thus, the inserts interface with one another.

Claim 59: Rockwood teaches the insert may be attached into the cavity by way of adhesive. See col. 3, lines 1-10.

Claims 60-64: Pierce and Rockwood are silent regarding the color as recited in claim 60, the outline being correlated to a portion of a motor vehicle as recited in claim 61, the surface profile being a flat, concave or convex, the indicia provided to the elements or inserts as recited in claims 62; the insert being provided with an indicia

Art Unit: 1775

associated with the number of vehicles purchased as recited in claim 63-64 however, since Van Houten's teaches the decorative inserts may be replaceable or interchangeable and that the turbine pocket may take on any number of various geometries so that many different ornamental designs can be provided, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the interchangeable inserts of Van Houten with various designs, shapes, colors and profiles in order to decorate or accent the medallion or emblem or a vehicle according to the users individual taste.

Claims 65-67: Rockwood and Houten teach the device may be attached to a vehicle.

Response to Applicant's Arguments/Remarks

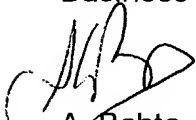
Applicant's arguments with respect to claims 1-34 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abraham Bahta whose telephone number is (571) 272-1352. The examiner can normally be reached on Monday - Friday; 11:30 am - 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1775

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


A. Bahta
06/21/04


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SUPERVISORY PATENT EXAMINER